

Appl. No. 10/537,135
Response to Final Action of May 17, 2010

EXPEDITED PROCEDURE
PATENT
Docket No.: US020476US
Customer No. 24737

REMARKS

Applicant submits that this Amendment After Final Rejection places this application in condition for allowance by amending claims in manners that are believed to render all pending claims allowable over the cited art and/or at least place this application in better form for appeal. This Amendment is necessary to clarify certain claim limitations, in addition to distinguish over newly cited art, and furthermore was not earlier presented because Applicant believed that the prior response(s) placed this application in condition for allowance, for at least the reasons discussed in those responses. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or to reduce the number of issues, is requested under 37 C.F.R. §1.116.

In the event that the Office declines to enter the present Amendment, and (i) any portion of the present Amendment would place some of the claims in better form for appeal if a separate paper were filed containing only such amendments or (ii) any proposed amendment to any claim would render that claim allowable, Applicant respectfully requests that the Office inform Applicant of the same pursuant to MPEP §714.13.

By this amendment, claim 19 has been canceled. Claims 1 and 21 have been amended. Claims 1-18 and 20-22 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, is respectfully requested.

Rejection under 35 U.S.C. §103

Claims 1-18, 21 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gutta et al. (WO 02/071315, hereinafter “**Gutta**”) in view of Liu (US 6,553,281, hereinafter “**Liu**”). With respect to claim 1, Applicant respectfully traverses

this rejection on the grounds that the **Gutta** and **Liu** references are defective in establishing a *prima facie* case of obviousness.

Independent claim 1, as now presented, more clearly recites, *inter alia*, "wherein the processor is further configured to (iv) *monitor* the positions of the subject and device ... and (v) *display a confusion warning notice* on a screen *in response to monitoring a change* in the subject's position with respect to an object *that might cause the device to confuse* the subject, the *confusion warning notice* being displayed for a situation in which the subject moves so that *an orientation of an image displayed via the device would appear to change*" (emphasis added). Support for the amendments to claim 1 (as well as for claim 21) can be found in the specification at least on page 10, lines 10-15 and in originally filed claim 19 (now canceled). As amended, the claimed embodiment would be highly desirable for a surgeon performing a medical procedure and, in particular, with respect to the surgeon's hands or with respect to an instrument during surgery (page 10, line 1). The amendments are supported by the specification and drawings as originally filed, thus no new matter has been introduced.

Applicant submits that neither Gutta nor Liu discloses at least the aforementioned feature of independent claim 1. In particular, it is submitted that the primary citation to **Gutta** does not disclose the claimed processor configured to *display a confusion warning notice* on a screen *in response to monitoring a change* in the subject's position with respect to an object *that might cause the device to confuse* the subject. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of **Gutta** and **Liu** is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The applicants further note that the Office Action (Office Action, page 4) included a rejection of claim 19 (now canceled) as being unpatentable over **Gutta** in view of **Liu** and further in view of **Jeong** (US 6,348,928). The limitations of claim 19 have been incorporated into claim 1, with some additional clarification, as presented herein. In view of the amendments to claim 1, applicants further submit that neither Gutta, Liu, nor Jeong discloses at least the aforementioned feature of independent claim 1. In particular, the tertiary citation to **Jeong** does not disclose the claimed processor configured to *display a confusion warning notice* on a screen *in response to monitoring a change in the subject's position with respect to an object that might cause the device to confuse the subject*. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of **Gutta, Liu** and **Jeong** is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Office Action (section 6 of the Office Action dated 1/26/10) concedes that **Gutta** fails to particularly disclose a warning is displayed on a screen if certain changes in the positions are detected (Office Action, section 6, dated 1/26/10). Nonetheless, the Office Action contends that the tertiary citation to **Jeong** provides this necessary disclosure. (Office Action, section 6, dated 1/26/10). As discussed above, claim 1 has been amended for clarification, including, clarification over the newly cited reference **Liu**. In view thereof and as will be explained further herein below, this contention that **Jeong** provides necessary disclosure is respectfully traversed.

Jeong relates to an apparatus for automatically rotating a visual display unit (Jeong, abstract). **Jeong** discloses a warning message generation unit 50 that generates a warning message if a body temperature of the viewer is not sensed (Jeong, FIG. 2 and Col. 3, lines 32-35). In addition, the “warning message ... is outputted through the sound processing unit” (Jeong, Col. 3, lines 49-50). However, in view of **Joeng**'s use of a sound warning message as discussed above and in **Jeong**, it is

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unknown how **Jeong**'s usage of a warning message could be understood to read on the limitation of "*display a confusion warning notice* on a screen *in response to monitoring a change* in the subject's position with respect to an object *that might cause the device to confuse* the subject, the *confusion warning notice* being displayed for a situation in which the subject moves so that *an orientation of an image displayed via the device would appear to change*" as is recited in claim 1. Thus, **Jeong** does not provide a disclosure that teaches the aforementioned feature of independent claim 1, nor does **Jeong** remedy the aforementioned, conceded deficiency in the primary citation to **Gutta** in view of **Liu**.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. §103 are respectfully requested. Claims 2-18 depend from and further limit independent claim 1 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof is now believed overcome.

Claim 21 has been amended in a manner similar to the amendments to claim 1. Accordingly, for similar reasons as stated with respect to overcoming the rejection of claim 1, claim 21 is believed allowable and an early formal notice thereof is requested. Claim 22 depends from and further limits independent claim 21 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Claims 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Gutta** et al. in view **Liu** and further in view of **Jeong** (US 6,348,928, hereinafter “**Jeong**”). Applicant respectfully traverses this rejection for at least the following reasons. With respect to claim 19, the same has been canceled herein, thus rendering the rejection thereof now moot. With respect to claim 20, the same depends from and further limits allowable independent claim 1 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application. In addition, the Office Action contains a number of statements characterizing the claims and the prior art. Regardless of whether such statements are addressed by Applicant, Applicant refuses to subscribe to any of these statements, unless expressly indicated by Applicant.

It is clear from all of the foregoing that independent claims 1 and 21 are in condition for allowance. Claims 2-18 and 20 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 22 depends from and further limits independent claim 21 and therefore is allowable as well.

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The matters identified in the Office Action of May 17, 2010 are now believed resolved. Accordingly, the application is believed to be in proper condition for allowance. The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. Withdrawal of the final action and issuance of an early formal notice of allowance of claims 1-18 and 20-22 is requested.

Respectfully submitted,

By: /Michael J. Balconi-Lamica/

Michael J. Balconi-Lamica
Registration No. 34,291
for Charles E. Kosinski, Reg. No. 39,254

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Mail all correspondence to:

Charles E. Kosinski, Esq.
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, New York 10510-8001, USA
Telephone: (724) 387-3746
email: charles.kosinski@philips.com
Facsimile: 914-332-0615

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